

REMARKS

In response to the Final Office Action dated March 10, 2010, the Assignee respectfully requests reconsideration. To further the prosecution of this application, each of the objections and rejections set forth in the Office Action has been carefully considered and is addressed below. The application is believed to be in condition for allowance.

I. Summary of Telephone Conference With Examiner

The Assignee's representatives Daniel T. Wehner and Richard F. Giunta thank Examiner Neway and his supervisor for the courtesies extended in granting and conducting a telephone interview on April 27, 2010, the substance of which is summarized herein. During the telephone interview, independent claim 1 and the cited references Brittan, Silverman, and Luther were discussed. Specifically, the process of inserting pauses in spelled words in the system of Silverman and the option for a user to specify whether unknown words are spelled or pronounced in the system of Luther were discussed in view of the limitation of claim 1 that recites, "inserting at least one third pause within the output of the synthesized speech of the uncommon word to increase the duration of the uncommon word by pronouncing the uncommon word in at least two pronounced portions separated by the at least one third pause."

Assignee's representatives asked the Examiner to clarify how he believed the purported combination of Brittan, Silverman, and Luther teaches the above-quoted limitation of claim 1. The Examiner conceded that neither Brittan nor Silverman nor Luther when considered individually discloses inserting a pause in a pronounced word. However, the Examiner asserted that he considered the combination of Silverman and Luther to teach the above-quoted limitation despite that fact that neither of the references explicitly teaches this limitation. Assignee's representatives asked the Examiner how the combination of Silverman and Luther could possibly show a feature that is not disclosed in either Silverman or Luther. With all due respect, no clear answer was provided that demonstrates that the rejection can properly be maintained. In addition to the teachings of the references, the Examiner indicated that his personal experience is that people sometimes pronounce words by separating the pronounced word into syllables separated by pauses. The undersigned pointed out that the rejection of record is not based on any alleged "personal

experience” of the Examiner and that such a rejection would raise a number of issues (as discussed below).

No agreement was reached and the Examiner’s supervisor proposed that the Assignee file a Notice of Appeal with a Pre-Appeal Brief Request for Review including arguments to support the Assignee’s position so that additional eyes would review the issue. However, after reviewing the MPEP further, the basis for the rejection is believed to be clearly improper for reasons discussed below, so that the Assignee respectfully requests that the Examiner reconsider the rejections in view of the remarks below.

I. Rejections Over the Prior Art

Each of the independent claims (i.e., claims 1, 9, and 18) is rejected under 35 U.S.C. §103 as purportedly being obvious over Brittan in view of Silverman and Luther, and each of the dependent claims is rejected under §103 over the same combination or further in view of Lu. These rejections are respectfully traversed.

MPEP §2143 lists several examples of rationales that may be used to establish a *prima facie* case of obviousness (i.e., combining prior art elements according to known methods to yield predictable results, simple substitution of one known element for another to obtain predictable results, etc.). As a preliminary matter, the Assignee respectfully notes that the Office Action fails to explicitly indicate any of the rationales set forth in MPEP §2143 as a basis for its rejections. While not explicit from the text of the Office Action, the Office Action appears to rely on the first rationale, “(A) combining prior art elements according to known methods to yield predictable results,” in support of the assertion that Applicants’ independent claims are obvious in view of the respective cited combinations of references.

MPEP §2143(A) describes in detail the requirements for rejecting a claim based on this rationale. In particular, the Office Action **must** articulate, *inter alia*, “a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.” (MPEP §2143(A)).

The Office Action has failed to establish a *prima facie* case of obviousness because the first requirement set forth in MPEP §2143(A) is not met because the limitation “inserting at least one third pause within the output of the synthesized speech of the uncommon word to increase the duration of the uncommon word by pronouncing the uncommon word in at least two pronounced portions separated by the at least one third pause” is not taught in any of the cited art of record.

As described above, during the telephone conference, the Examiner conceded that none of the cited references discloses the above-quoted limitation of each of the independent claims, but asserted that it would have been obvious, based on the cited references *and his own experience* that words can be pronounced by separating a pronounced word into syllables separated by pauses. However, as described above, MPEP §2143(A) requires that the USPTO clearly articulate “a finding that *the prior art* included each element claimed ... (emphasis added).” MPEP 2144.03(A) makes clear that it is improper for the Examiner to rely upon his own understanding or experience rather than *evidence in the record*, citing Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

The Office Action has failed to meet its burden (See MPEP §2143(A)) of clearly articulating “a finding that *the prior art* included each element claimed ... (emphasis added)” because the Office Action provides no evidence that one of ordinary skill in the art at the time of the invention would have modified the system of Silverman, which **inserts pauses in spelled words**, to insert pauses in pronounced words. Absent such evidence, a *prima facie* case of obviousness has not been established for any of the independent claims, and it is respectfully requested that the rejections of each of independent claims 1, 9, and 18 under 35 U.S.C. §103 be withdrawn.

Claims 2-7 depend from claim 1, claims 10-15 depend from claim 9, and claims 19-23 depend from claim 18. Each of these dependent claims patentably distinguishes over the cited references for at least the same reasons as the independent claim from which it depends.

II. General Comments on Dependent Claims

Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, for the sake of brevity, the Assignee believes that it is unnecessary at this time to argue the further distinguishing features of the dependent claims. However, the Assignee does not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor does the Assignee concur that the basis for rejection of any of the dependent claims is proper. Therefore, the Assignee reserves the right to specifically address the further patentability of the dependent claims in the future.


CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Assignee hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. N0484.70764US00.

Dated: May 10, 2010

Respectfully submitted,
Nuance Communications, Inc.

By 
Richard F. Giunta, Reg. No. 36, 149
WOLF, GREENFIELD & SACKS, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
617.646.8000